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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,577	06/09/2000	Charles A. Eldering	T702-03	2970
27832	7590	08/02/2005	EXAMINER	
TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME 6206 KELLERS CHURCH ROAD PIPERSVILLE, PA 18947				RETTA, YEHDEGA
ART UNIT		PAPER NUMBER		
3622				

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/591,577	ELDERING ET AL.
	Examiner Yehdega Retta	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 November 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 76-121 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 76-121 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed November 4, 2003. Applicant amended claims 76, 86, 92 and 110. Claims 76-121 are currently pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 76-121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite a first set of consumers and retrieving demographic information for a second set of consumer, wherein there is overlap between the first set and second set of consumers; applying heuristic rules for a third set of consumers wherein the set of consumers includes a subset of the first set of consumers; and driving a fourth set of consumers likely to be interested to a particular advertisement wherein the fourth includes consumers within the third set. All these steps are not taught in applicant's specification. Applicant's specification teaches generating subscriber profiles from transaction and demographic information, however does not teach taking the steps recited in the claims. Applicant is required to amend the claims to reflect what is disclosed. If applicant is convinced that the disclosure discloses the steps claimed then applicant should point out the correlation of the claimed feature with the disclosure.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 76-121 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 76 recites, “the discretionary elements include target market characteristics which need not be representative of an actual existing market or single purchase segment”. It is unclear what the discretionary elements include, since as claimed it can include one that represent actual existing market or not. Applicant by defining the invention in terms of what it is not, rather than pointing out the invention, rendered the claim indefinite. Applicant fails to distinctly and particularly point out what he invented.

Claim 86 recites, “discretionary element is not representative of a single purchasing element”, “the discretionary element not directly identifiable from consumer transaction records”.

Claim 92 recites, “discretionary element includes a selection of target market characteristics not typically associated with item being advertised”.

Claims 93 and 94 recite “consideration not representative of any particular group of present consumers of the item”.

Claim 95 recites, “target market characteristics are not representative of actual consumers of the item”.

Claim 96 recites, “target market characteristics are not representative of actual existing market”.

Claim 97 recites, “target market characteristics are not representative of a single purchase segment”.

Claim 109 recites, “the discretionary elements include target market characteristics which need not be representative of an actual existing market or single purchase segment”.

Claim 110 recites, “wherein the heuristic rules associated the consumer purchase transaction and the consumer transaction attributes to non-transaction related consumer attributes”, “to generate non-transaction related consumer attributes”.

Claim 115 recites, “includes at least one of consumer transaction records, demographic information, and non-transaction related attributes”, “wherein the heuristic rules associate the consumer transaction records and to non-transaction related attributes”, “wherein the advertisement profile includes a selection of target market characteristics not typically associated with item being advertised”.

All the negatively claimed limitation, in light of applicant’s disclosure, could not be determined as to what those terms encompass.

All dependent claims are rejected as being dependent to rejected claims.

For the purpose of applying art, the claimed invention will be interpreted in light of applicant’s disclosure.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 76-78, 80-121 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks et al. (US 6,463,585).

Regarding claim 76, Hendricks teaches retrieving consumer transaction records for a set of consumers from plurality of purchases; retrieving demographic information of the consumer; creating profiles for each subset or group of consumer which are a subset of subgroup or a first group (subscribers) and applying heuristic rules to a subset of the consumer transaction records for a group or a subset of the subscribers (customers) to generate discretionary elements and deriving a set of consumer likely to be interested in a particular advertisement (see col. 20 lines 4-48, col. 26 line 42 to col. 27 line 6, col. 29 lines 1-44, col. 35 lines 1-28, col. 66 line 35 to col. 67 line 4, lines 52-62, col. 76 line 66 to col. 77 line 23, col. 78 line 44 to col. 79 line 4).

Regarding claim 77, Hendricks teaches plurality of purchases including point-of sale purchases (see col. 11 lines 30-50, col. 42 lines 52-62, col. 44 lines 8-23).

Regarding claim 78, Hendricks teaches consumer transaction records include consumer television interaction transaction (see col. 2 lines 41-49, col. 3 lines 10-17, col. 4 lines 6-67).

Regarding claim 80, Hendricks teaches demographic information is associated with particular geographic regions (see col. 5 lines 1-14, col. 26 lines 54-67, Table D, Table E).

Regarding claim 81, Hendricks teaches the demographic information includes information retrieved from combination of public and private database (see col. 11 lines 31-40, col. 29 lines 6-32).

Regarding claim 82, Hendricks teaches demographic information includes at least some subset of age, income, family size, etc., (see col. 5 lines 5-14, col. 66 lines 57-67, Table E).

Regarding claims 83, Hendricks teaches wherein demographic information is probabilistic (see col. 66 line 58 to col. 67 line 4).

Regarding claim 84, Hendricks teaches segmenting a group into a plurality of groups wherein each group may represent a market segment (see col. 29 lines 6-32, col. 30 lines 29-53, Table D, Table G).

Regarding claim 85, Hendricks teaches applying an advertisement to at least a group of consumer to generate a list of consumers having the specific discretionary element of interest to advertiser (see col. 4 lines 11-17, col. 44 lines 7-65).

Regarding claims 86-88, Hendricks teaches retrieving consumer transaction records for a set of consumers from plurality of purchases; retrieving demographic information of the consumer; creating profiles for each subset or group of consumer which are a subset or subgroup of a first group (subscribers) and applying to a subset of the consumer transaction records for a group or a subset of the subscribers (customers) likely to be interested in a particular

advertisement wherein a discretionary elements of interest to an advertiser, wherein a targeted list of consumer having the specific discretionary element of interest to the advertiser is produced (see col. 20 lines 4-48, col. 26 line 42 to col. 27 line 6, col. 29 lines 1-44, col. 35 lines 1-28, col. 66 line 35 to col. 67 line 4, lines 52-62, col. 76 line 66 to col. 77 line 23, col. 78 line 44 to col. 79 line 4).

Claim 89 is rejected as stated above in claim 81.

Claim 90 is rejected as stated above in claim 83.

Claim 91 is rejected as stated above in claim 80.

Regarding claims 92-99, 103-109, 113-121, Hendricks teaches selecting a set of consumers (individual or groups) from a plurality of consumers; retrieving a discretionary element for an advertisement which includes a selection of target market characteristics; performing a linear operation on a database having a demographic and transaction information to determine applicability of the advertisement to a set of consumers; wherein the target market characteristics include a set of demographic and product preference; including demographic groups; correlating the discretionary element and the demographic and transaction information contained in the consumer database for the set of consumers; applying heuristic rules to generate discretionary elements (see col. 4 lines 12-17, col. 5 lines 1-52, col. 11 lines 25-50, col. 20 lines 4-67, col. 26 line 42 to col. 27 line 6, col. 29 lines 1-44, col. 30 lines 21-53, col. 31 lines 27-55, col. 66 line 36 to col. 67 line 4, lines 34-62).

Regarding claims 100-102, Hendricks teaches wherein the set of consumers are identified anonymously (see col. 44 lines 7-67).

Claim 110 is rejected as stated above in claim 76.

Regarding claim 111, Hendricks teaches query the consumer database in controlled manner to prevent in appropriate measurements from being made (see col. 35 to col. 38 line 59).

Claim 112 is rejected as stated above in claim 100.

Claims 76 and 79 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks et al. (US 6,463,585).

Regarding claims 76 and 79, Hendricks teaches retrieving consumer transaction records for a set of consumers from plurality of purchases; retrieving demographic information of the consumer; creating profiles for each subset or group of consumer which are a subset or subgroup of a first group (subscribers) and applying heuristic rules to a subset of the consumer transaction records for a group or a subset of the subscribers (customers) to generate discretionary elements and deriving a set of consumer likely to be interested in a particular advertisement; wherein the transaction records includes consumer internet interaction transactions (see col. 5 line 22 to col. 6 line 33, col. 7 lines 10-46, col. 11 lines 1-51, col. 17 lines 20-40, col. 18 line 39 to col. 19 line 32, col. 40 lines 3-57, col. 60 lines 6-37).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR

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